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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,125	11/21/2005	Jorg Heller	STERN21.003APC	8936
20995 7590 12/31/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER WONG, EDNA	
			ART UNIT 1795	PAPER NUMBER
			NOTIFICATION DATE 12/31/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/528,125

Applicant(s)

HELLER ET AL.

Examiner

Edna Wong

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

This is in response to the Amendment dated November 1, 2007. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Response to Arguments

Claim Objections

Claim 1 has been objected to because of minor informalities.

The objection of claim 1 has been withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 112

Claims 1-18 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regards to claim 1, line 3, the rejection under 35 U.S.C. 112, first paragraph, has been withdrawn in view of Applicants' remarks.

With regards to claim 1, line 4, the rejection under 35 U.S.C. 112, first paragraph, is as applied in the Office Action dated August 3, 2007 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that as discussed in the response to the previous Office

Action, electrolytic coating of the material according to the claimed invention is carried out in an electrolytic bath which comprises a halogen-free, aprotic solvent and the electrolyte according to general formulas I and II. It can be seen that neither the solvent nor the electrolyte comprises any halogen, and therefore, it is implicit in the Specification that the whole electrolyte bath is a halogen-free electrolyte bath.

In response, although the electrolytic bath comprises a halogen-free, aprotic solvent and a halogen-free electrolyte, the electrolytic bath is still not halogen-free because the transitional term "**comprising**" (recited in claim 1, lines 4 and 9) is inclusive or open-ended and does not exclude additional, unrecited elements or method steps (MPEP § 2111.03). Thus, the claimed electrolytic bath is open to include halogen elements.

Furthermore, any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion (MPEP § 2173.05(i)).

Claim Rejections - 35 USC § 103

Claims **1-18** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Dotzer et al.** (US Patent No. 3,969,195) in combination with **DE 198 55 666** ('666) and **Lehmkuhl et al.** (US Patent No. 6,652,730 B1).

The rejection of claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Dotzer et al. in combination with DE 198 55 666 ('666) and Lehmkuhl et al. has been

withdrawn in view of Applicants' remarks.

Response to Amendment

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

Claims 1-18 define over the prior art of record because the prior art does not teach or suggest a method for electrolytic coating of a material with an aluminum, magnesium or alloys of aluminum and magnesium, said method comprising the steps of immersing, reversing and performing as presently claimed, esp., the steps of reversing polarity of the material, thereby performing the electrolytic coating in the same electrolyte immediately thereafter.

The prior art does not contain any language that teaches or suggests the above. Dotzer et al. teach that while articles made of beryllium or aluminum may also be anodically dissolved in aluminizing electrolyte media containing halides, particularly hydro-fluorides, this cannot be done with articles made of magnesium or zinc, because of the formation of insulating surface layers of a metal halide, especially MgF_2 or ZnF_2 . Electrolytes suitable for effecting anodic pretreatment of any of the light metals referred to herein are the tetra-alkyl alanate-complexes which are free of halide ions, e.g.:



The mixed sodium-potassium salts of the tetraethylalanate, which melts at $70^\circ C$, is

particularly advantageous. The sodium salt first melts at 128°C. Light metal articles which are anodically treated in these molten electrolytes and thereby pretreated with respect to their surface, may be immersed under inert gas into the electroplating cell, still wet with the pretreating electrolyte, and electroplated with aluminum by means of cathodic action. This is not a teaching of performing the electrolytic coating in the same electrolyte immediately thereafter. Therefore, a person skilled in the art would not have been motivated to adopt the above conditions, and a prima facie case of obviousness cannot be established.

Claims 1-18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

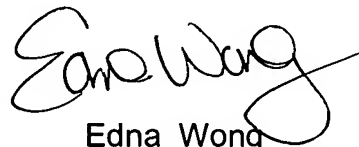
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Edna Wong
Primary Examiner
Art Unit 1795

EW
December 20, 2007